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IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

APPLICATION OF )  
MARTIN G. REIFFIN )  
FILED: APRIL 3, 1985 )  
FOR : COMPUTER SYSTEM WITH )  
REAL-TIME COMPIRATION )  
SERIAL NO. 719,507 )

ART UNIT 232 ✓

PETITION TO COMMISSIONER

Applicant respectfully petitions the Commissioner of Patents and Trademarks in the exercise of his supervisory authority under 37 CFR 1.181 to direct:

1. That the Examiner designate specifically, by drawing reference numerals and specification line numbers, wherein the cited Lawrence et al. patent is alleged to disclose hardware or software for performing each of the functions relied upon by the Examiner as anticipatory or suggestive of any aspect of applicant's claims;

2. That, for each said function for which the Lawrence et al. patent discloses neither hardware nor software for performing the function, the Examiner either submit an affidavit or cite a prior patent or publication showing that either hardware or software for performing the function in question was conventional at the time of filing of applicant's parent application Serial No. 425,612;

3. That the recited functions in the "means" clauses in applicant's claims, such as "compiling", "scanning", "parsing",

"translating", "lexical analysis", "syntactic analysis" and similar functional limitations may not be ignored or dismissed by the Examiner as "merely labels of some functions" [sic], and that these recited functions instead be properly considered in determining the patentability of applicant's claims;

4. That the finality of the Action of September 18, 1987 be withdrawn; and

5. That a new date for applicant's response be set.

#### GROUNDS OF THIS PETITION

The grounds of this petition are summarized as follows:

1. The Examiner has repeatedly failed to respond to applicant's request that he specify wherein the Lawrence et al. patent discloses either hardware or software for performing the several functions relied upon by the Examiner in the rejection of applicant's claims, and has thereby failed to state clearly the pertinence of this reference and the grounds of the rejection;

2. The Examiner has repeatedly failed to respond to applicant's request that he cite legal authority in support of his position that a reference disclosing neither hardware nor software may nevertheless be deemed "enabling" so as to constitute a valid anticipation;

3. The rejection of applicant's claims is meaningless, incomprehensible, without legal basis and improper on its face in that the rejection is based upon ignoring, discounting or

dismissing the functions recited in the "means" clauses of the claims as "merely labels of some functions" [sic].

THE FAILURE TO SPECIFY  
THE HARDWARE OR SOFTWARE IN LAWRENCE

Applicant has repeatedly, both in the present application and in the copending parent application Serial No. 425,612, urged that the Lawrence et al. patent is not a valid reference because it is not "enabling" as required by In re Wilder (CCPA) 166 USPQ 545 and In re Borst (CCPA) 145 USPQ 554.

That is, the reference discloses neither hardware nor software for performing any of the functions perfunctorily mentioned in the patent and relied upon by the Examiner.

In his response to the Action of September 4, 1986 applicant requested:

"If the Examiner adheres to the rejection on Lawrence it is respectfully requested that the Examiner designate specifically, by drawing reference numerals and specification line numbers, wherein this patent discloses hardware or software for performing each of the functions relied upon as anticipating or suggesting any aspect of applicant's claims."

In his response to the Action of March 19, 1987 applicant incorporated by reference his discussion in his response in copending application Serial No. 425,612 in which applicant requested:

"If the Examiner adheres to his reliance upon the Lawrence reference he is respectfully requested to cite legal authority in support of his contention that a reference disclosing neither hardware nor software may in itself be 'enabling' so as to constitute an anticipatory 'teaching'."

The Examiner has failed to cite any legal authority that

a reference disclosing neither hardware nor software may nevertheless be "enabling" so as to constitute a valid anticipation, and has failed to designate wherein the Lawrence patent discloses either hardware or software for performing the functions relied upon in the Action. The Examiner has not even attempted to establish by references or by affidavit that the non-enabled functions and the means for achieving them were conventional.

Furthermore, entirely aside from the requirement of the Wilder and Borst cases that a disclosure must be "enabling" to constitute a valid reference, the Examiner is "required both by law and the rules of practice of the Patent Office to clearly state the reasons for opinion." In re O'Keefe (CCPA 1953) 97 USPQ 157,160. The pertinence of the references, if not obvious, must be "clearly explained." In re Carter (CCPA 1954) 101 USPQ 290,292; In re Mullin et al. (CCPA 1973) 179 USPQ 97,100.

A rejection which fails to identify the hardware or software upon which the Examiner relies is not "clearly explained" and the Examiner has thereby failed "to clearly state the reasons for opinion."

Paragraph 8 on Page 5 of the Action of September 18, 1987 (Paper No. 13) argues that "the burden was shifted to applicant...to rebut the presumption of operability" of the Lawrence reference. The Examiner overlooks that this is not the issue raised by applicant. Applicant does not contend that the hardware or software disclosed in Lawrence is inoperative. Instead, applicant contends that no such hardware or software is disclosed, operative or otherwise.

Furthermore, if the Examiner refuses to specify the hardware or software upon which he relies, how can applicant possibly be expected to prove that this unknown, unspecified, undesignated (and undisclosed) hardware or software is inoperative?

#### THE REFUSAL TO CONSIDER FUNCTIONAL LIMITATIONS

Paragraph 10 of the Action dated September 18, 1987 (Paper No. 13) discounts or disregards numerous functions recited in the "means" clauses of applicant's claims because "they are merely labels of some functions" or "are merely the label of some functions performed by a program on some data."

An action which dismisses or refuses to consider functional statements recited in claimed "means" clauses is improper on its face, is manifestly contrary to the statute and case law, and does not constitute a meaningful ground of rejection.

As stated by the Court of Appeals for the Federal Circuit in RCA Corp. v. Applied Digital Data Systems, Inc. et al. (CAFC 1984) 221 USPQ 385, 388, 389:

"Furthermore, with an element expressed in terms of a means plus function, 'absent structure [in a prior art reference] which is capable of performing the functional limitation of the "means," [the prior art reference] does not meet the claim.' In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).  
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"Anticipation is determined by comparison of the reference with the claims. The claims here define the invention of several specific 'means-plus-function' elements. The limitations which must be met by an anticipatory reference are those set forth in each statement of function. In re Mott, 557 F.2d 266, 269, 199 USPQ 305, 307 (CCPA 1977). Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device

embodying the same general overall concept."

CONCLUSION

It is therefore respectfully requested that the Commissioner exercise his supervisory authority in the manner and for the reasons stated above.

Respectfully submitted,



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Martin G. Reiffin,  
Applicant  
545 Pierce Street  
#2404  
Albany, CA 94706  
Telephone: (415) 524-8879